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EXAMINER

HO, CHUONG T

ART UNIT PAPER NUMBER

2664

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,867

Applicant(s)

NAYLOR ET AL.

Examiner

Chuong Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claims 1-11 are pending.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claim 1 contains subject matter . "A telephone line interface to receive an incoming fax transmission sent with **an auxiliary data field**" which was not described in the specification.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claim 6 contains subject matter wherein the incoming fax transmission has **an auxiliary data field**" which was not described in the specification .

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "**the data field**" in "a computing device to execute a program that includes a function which converts the fax image into a computer-readable format, a function which reads **the data field** received with the fax transmission". There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "**the data field**" in "the computing device is to insert information form the data field into a from-field of an email message in which said

portion of the fax image is to be routed". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloomfield (U.S. Patent. No. 6,707,580) "Provisional application No. 60/048,064, filed on May 30, 1997, and provisional application No. 60/028,405, filed on Oct 15, 1996".

In the claim 1, see figures 1, 4, 5, 7, 11A, 11C, Bloomfield discloses, see figure 5, "283, 288, 292, 296", col. 7, lines 5-18, **the Fax-server 110** service the call by, among other tasks: verifying (against a stored list of valid identification codes of **fax interface device 102**) that the call is to be processed "Check **the fax device** is authorized to user the Fax-Server 110"; (see col. 8, lines 43-50, figure 4, the E-mail message 270 comprises a message portion 272, described below, and attached image data file 274. The attached image data file 274 includes image data representative of the document being communicated, via E-mail, from the sender's fax machine 106 to the recipient's E-mail 118 by the FAX/Email communication system 100); (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290, of the header

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portion 276, as well as the text 300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received by the Fax-Server 110** during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4); comprising:

A telephone line interface (FAX-SERVER 110), see figures 1, 4, 5, 11A, to receive an incoming fax transmission sent with an auxiliary data field (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290 **"Auxiliary data fields"**, of the header portion 276, as well as the text 300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received by the Fax-Server 110** during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4) (see col. 9, lines 1-25);

A fax processor to convert the fax transmission into a fax image (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving and **converting** data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, **for creating**

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an addressed E-mail message to which the computer-readable data file is attached, and for delivering the E-mail and attachment to a desired recipient);

A computing device to execute a program that includes a function which converts the fax image into a computer-readable format (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving and converting data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, for creating an addressed E-mail message to which the computer-readable data file is attached, and for delivering the E-mail and attachment to a desired recipient) (the present invention's handling of the fax message by converting the message to a computer-readable image file and attaching it to a system generated E-mail message), a function which reads the data field received with the fax transmission, and a function that causes a portion of the fax image to be routed, in said computer-readable format, to an email address via an email message, wherein information from the data field is to be inserted into a from-field of the email message.

5. In the claims 2, 3, 9, 10, Bloomfield discloses the computer device is to execute a further function which includes a decoding viewer in an email transmission to a recipient of message, to facilitate viewing of message (see col. 14, lines 10-15, lines 35-37).

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6. In the claims 4, 11, Bloomfield discloses wherein the information inserted into the from-field of the email messages is a return email address of a sender of fax transmission (see col. 9, lines 1-25).

7. In the claim 5, Bloomfield see figures 1, 4, 5, 7, 11A, 11C, Bloomfield discloses, see figure 5, "283, 288, 292, 296", col. 7, lines 5-18, **the Fax-server 110** service the call by, among other tasks: verifying (against a stored list of valid identification codes of **fax interface device 102**) that the call is to be processed "Check **the fax device** is authorized to user the Fax-Server 110"; (see col. 8, lines 43-50, figure 4, the E-mail message 270 comprises a message portion 272, described below, and attached image data file 274. The attached image data file 274 includes image data representative of the document being communicated, via E-mail, from the sender's fax machine 106 to the recipient's E-mail 118 by the FAX/Email communication system 100); (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290, of the header portion 276, as well as the text 300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received by the Fax-Server 110** during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4); comprising:

A telephone line interface (FAX-SERVER 110), see figures 1, 4, 5, 11A, to receive an incoming fax transmission (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290 **"data fields"**, of the header portion 276, as well as the text

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300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received by the Fax-Server 110** during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4) (see col. 9, lines 1-25);

A fax processor to convert the fax transmission into a fax image (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving and **converting** data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, **for creating** an addressed E-mail message to which the computer-readable data file is attached, and for delivering the E-mail and attachment to a desired recipient);

A computing device to execute a program that includes a function which converts the fax image into a computer-readable format (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving **and converting** data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, **for creating** an addressed E-mail message to which the computer-readable data file is attached, and for

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delivering the E-mail and attachment to a desired recipient) (the present invention's handling of the fax message by converting the message to a computer-readable image file and attaching it to a system generated E-mail message), a function that performs a look-up operation using the header information to derive an email address (see figure 5, col. 9, lines 1-25, lines 63-67) , and a function that causes a portion of the fax image to be routed, in said computer-readable format, to the email address, wherein the computing device is to execute a further function which includes a decoding viewer in a email transmission to a recipient of said message, to facilitate viewing of message (see col. 14, lines 10-15, lines 33-37).

8. In the claim 6, Bloomfield discloses the incoming fax transmission has an auxiliary data field (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290 **"Auxiliary data fields"**, of the header portion 276, as well as the text 300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received by the Fax-Server 110** during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4) (see col. 9, lines 1-25), and the computing device is to insert information from the data field into a from-field of an email message in which portion of the fax image is to be routed (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving **and**

converting data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, for creating an addressed E-mail message to which the computer-readable data file is attached, and for delivering the E-mail and attachment to a desired recipient) (the present invention's handling of the fax message by converting the message to a computer-readable image file and attaching it to a system generated E-mail message).

9. In the claim 7, Bloomfield discloses the information inserted into the from-field of the email messages is a return email address (see figure 5, col. 9, lines 1-25, of a sender of fax transmission.

10. In the claim 8, see figures 1, 4, 5, 7, 11A, 11C, Bloomfield discloses, see figure 5, "283, 288, 292, 296", col. 7, lines 5-18, **the Fax-server 110** service the call by, among other tasks: verifying (against a stored list of valid identification codes of **fax interface device 102**) that the call is to be processed "Check **the fax device** is authorized to user the Fax-Server 110"; (see col. 8, lines 43-50, figure 4, the E-mail message 270 comprises a message portion 272, described below, and attached image data file 274. The attached image data file 274 includes image data representative of the document being communicated, via E-mail, from the sender's fax machine 106 to the recipient's E-mail 118 by the FAX/Email communication system 100); (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290, of the header portion 276, as well as the text 300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received**

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by the Fax-Server 110 during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4); comprising:

A telephone line interface (FAX-SERVER 110), see figures 1, 4, 5, 11A, to receive an incoming fax transmission including a data field from a sender (See figure 5, 11A, the information and data used to populate the "fields" 282, 286, 290 **"data fields"**, of the header portion 276, as well as the text 300 and link data 297 of the body portion 280, as well as the informative data found in the textual portion 299 is all information and data **received by the Fax-Server 110** during step 1034 and 1036 of the process described below (see FIG. 11A) and/or generated at step 1074 of the process (see FIG. 11C), and is that information and data which constitutes the message portion 272 of the E-mail message 270 depicted in FIG.4) (see col. 9, lines 1-25);

A fax processor to convert the fax transmission into a fax image (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving and **converting** data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, **for creating** an addressed E-mail message to which the computer-readable data file is attached, and for delivering the E-mail and attachment to a desired recipient);

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A computing device to execute a program that includes a function which converts the fax image into a computer-readable format (see col. 2, lines 23-35, the present invention comprises apparatus and methods for the input of an E-mail address locally to a facsimile machine, for directing the transmission of the image to a remotely located FEM-GATEWAY, for receiving and converting data representative of an image scanned by the facsimile device (referred to herein as facsimile information) into a computer-readable data file formatted in an image data file format, for creating an addressed E-mail message to which the computer-readable data file is attached, and for delivering the E-mail and attachment to a desired recipient) (the present invention's handling of the fax message by converting the message to a computer-readable image file and attaching it to a system generated E-mail message), a function which reads the data field received with the fax transmission, and a function that causes a portion of the fax image to be routed, in said computer-readable format, to an email address via an email message, wherein the sender's return information taken from the data field (see col.9, lines 1-25) is to be inserted into the email message.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuong ho whose telephone number is (571)272-3133. The examiner can normally be reached on Monday-Friday from 8:00AM-4:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01/09/05

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